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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,736	09/06/2000	Chung-Ching Michael Wang	12192RR (NORTH 1967001)	9034
7590 11/15/2004			EXAMINER	
Andrew J Dillon DILLON & YUDELL LLP 8911 N. Capital of Texas Highway Suite 2110 Austin, TX 78759			FERRIS, DERRICK W	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,736

Applicant(s)

WANG ET AL.

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/2004 has been entered.
2. **Claims 32-36** are pending. Claims 1-31 are canceled.
3. Examiner **withdraws** the obviousness rejection to *Brown, Jr. et al.* in view of *Sexton et al.* in further view of *Noneman* and *Virtanen* for the claims as necessitated by amendment. Please see new rejection below based on the newly amended claims.
4. Examiner **withdraws** the obviousness rejection to *Brown, Jr. et al.* in view of *Sexton et al.* in further view of *Noneman*, *Virtanen* and *Boulos et al* for the claims as necessitated by amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

6. **Claims 32-36** is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

As to **claim 32**, please see Section 3.2.2 on page 5 of applicant's provisional specification. In particular, a service reference number is defined as SR_ID, a service option identifier is defined as SO, a multi-bit reserve field is defined as (SO_OMIT +

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RESERVED), a data block is defined as DATABLOCK, and a service option identifier omit indicator is defined as SO_OMIT. Note that SO_OMIT is 1 bit and part of the reserved field which is 4 bits. The key to the rejection is that applicant admits that SDB_SDU was taken from the TIA/EIA IS-707-A2 specification. As additional factual evidence, the examiner has supplied part of the TIA/EIA IS-707-A2 specification. Please note that although the reference is dated March 2001, the reference was officially published December 1999. Evidence of the publish date is also supplied on the TIA online website which is also attached to the reference. Hence TIA/EIA IS-707-A2 was published before applicant's specification and by another TIA/EIA. As such, see Section 2.2.10.3 starting on page 2-41 which teaches a short data burst format including the SO_OMIT field where the function of the SO_OMIT field is further defined on page 2-42 (i.e., all the above fields are mentioned using the same exact notation). The function of the SO_OMIT field provided teaches the further limitation of thereafter transmitting. CDMA is further taught on page 1.1. Thus applicant "derived" their invention from the above specification.

As to **claims 33-34**, see description of SO_OMIT which is set respectfully for either the mobile or the base station.

As to **claims 35 and 36**, see similar rejection to claim 32. Examiner furthermore notes that purpose of the TIA/EIA specification is for the execution of computer code to implement the method described throughout the specification.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123.

The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
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DWF


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

11/10/09